

REMARKS

Claims 1 - 61 are pending. By this amendment, claims 2, 11, and 15 are amended and claim 17 is cancelled. No new matter is introduced. Reconsideration and issuance of a Notice of Allowance are respectfully requested.

On page 2 the Office Action rejects claim 47 under 35 U.S.C. § 112, first paragraph. In particular, the Office Action states that claim 47 “claims that hardware is on a digital site” and then the Office Action asserts that “[w]hile hardware can contain the code for a digital site, it cannot be on a digital site as the site is digital and hardware is corporeal.” This rejection of claim 47 is respectfully traversed.

Applicant disagrees with the examiner: claim 47 actually recites that “the client site is on a digital communications network.” In other words, the client site is a node in a digital network. Claim 47 says nothing about hardware. Accordingly, claim 47 is patentable under 35 U.S.C. § 112, first paragraph, and withdrawal of the rejection is respectfully requested.

Also on page 2, the Office Action rejects claims 2, 11, 15, and 17 under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed.

Claims 2, 11, and 15 are amended and claim 17 is cancelled. Withdrawal of the rejection of claims 2, 11, 15, and 17 under 35 U.S.C. § 112, second paragraph is respectfully requested.

On page 3 the Office Action rejects claims 1, 2, 9, 13, 18 - 25, 27, 29 - 31, 35, 37, 39, 40, 45, 46, and 50 under 35 U.S.C. § 102 (b) “as being anticipated by telephone companies” This rejection is respectfully traversed.

In particular, and considering independent claims 1, 27, 37, and 45, the Office Action states that “it is old and well known for telephone companies to provide one or more hardware products (telephones), a metering mechanism coupled to the hardware products that acquires metrics data from the hardware product [sic], the metering data determines data to report on the operation of the products and generates reports, the metering mechanism is inherent in that bills are generated based on telephone usage and these inherently come from metering.”

In essence, the examiner is relying “taking official notice” of supposed facts in order to support the rejection of these claims. Nowhere does the examiner provide any documentation to support this rejection. In section 2144.03, the MPEP states “It would not be appropriate for the examiner to take official notice of facts without citing a prior art

reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.”

Applicant respectfully disagrees that all the elements of the independent claims are disclosed by any plain old telephone system (POTS). More specifically, the Applicant contends that no POTS ever included a “metering mechanism [that] determines data to report on the operation of the one or more hardware products (emphasis added),” as recited in each of the independent claims. Applicant further contends that a POTS would not anticipate other elements of the independent claims. In accordance with MPEP 2144.03, Applicant asks the examiner to provide specific documentary evidence to support the rejection of claims 1, 27, 37, and 45, and their respective dependent claims 2, 9, 13, 18 - 25, 29 - 31, 35, 39, 40, 46, and 50.

Because, as Applicant believes, the POTS does not disclose all the elements of claims 1, 27, 37, and 45, these claims are patentable. Claims 2, 9, 13, 18 - 25, 29 - 31, 35, 39, 40, 46, and 50 depend from their respective patentable base claims 1, 27, 37, and 45, and for this reason and the additional features they recite, claims 2, 9, 13, 18 - 25, 29 - 31, 35, 39, 40, 46, and 50 are also patentable. Withdrawal of the rejection of claims 1, 2, 9, 13, 18 - 25, 27, 29 - 31, 35, 37, 39, 40, 45, 46, and 50 under 35 U.S.C. § 102 (b) is respectfully requested.

On page 5 the Office Action rejects claims 1 - 4, 8 - 12, 16, 18 - 25, 27, 28, 32, 35, 37 - 41, 44, 45, 48, and 50 - 54 under 35 U.S.C. § 102(b) over U.S. Patent 5.745.884 to Carnegie et al. (hereafter Carnegie). This rejection is respectfully traversed.

The Office Action contends that Carnegie discloses “a hardware pay per use system (title) comprising one or more hardware products (col 4, lines 53 - 56), a metering agent that acquires metrics data (306, 316, as best seen in fig. 3), and a usage repository that generates reports on the received data (308, 318).”

Carnegie is directed to a system for collecting revenues from computer users when those computer users connect their computers through a public network, such as the Internet, to their home network or local area network. See, e.g., Abstract, column 4, lines 30 - 32. Carnegie does not disclose or suggest collecting metrics information related to the operation of the computers, merely the act of connection. See also, column 5, lines 45 - 52: Each time a remote user becomes connected to a home system ... the information may be stored for billing purposes on a per user, per connection basis.” Clearly, Carnegie’s system relates only to connectivity, not operation.

In contrast to Carnegie, each of the independent claims 1, 27, 37, and 45 recites a metering mechanism (or corresponding method) that acquires metrics data related to an

operation at the hardware products, wherein the metering mechanism determines data to report on the operation of the hardware products. Because Carnegie does not disclose or suggest all the elements of claims 1, 27, 37, and 45, these claims are patentable. Claims 2 - 4, 8 - 12, 16, 18 - 25, 28, 32, 35, 38 - 41, 44, 48, and 50 - 54 depend, respectively, from claims 1, 27, 37, and 45, and for this reason and the additional features they recite, claims 2 - 4, 8 - 12, 16, 18 - 25, 28, 32, 35, 38 - 41, 44, 48, and 50 - 54 are also patentable. Withdrawal of the rejection of claims 1 - 4, 8 - 12, 16, 18 - 25, 27, 28, 32, 35, 37 - 41, 44, 45, 48, and 50 - 54 under 35 U.S.C. § 102(b) is respectfully requested.

On page 7 the Office Action rejects claims 5 - 7, 13 - 15, 26, 29 - 31, 33, 34, 36, 42, 43, 46, 49, and 55 - 61 under 35 U.S.C. § 103(a). This rejection is respectfully traversed.

Claims 5 - 7, 13 - 15, 26, 29 - 31, 33, 34, 36, 42, 43, 46, 49, and 55 - 61 depend, respectively, from patentable claims 1, 27, 37, and 45. For this reason and the additional features they recite, claims 5 - 7, 13 - 15, 26, 29 - 31, 33, 34, 36, 42, 43, 46, 49, and 55 - 61 are also patentable. Withdrawal of the rejection of claims 5 - 7, 13 - 15, 26, 29 - 31, 33, 34, 36, 42, 43, 46, 49, and 55 - 61 under 35 U.S.C. § 103(a) is respectfully requested.

In view of the above remarks, Applicant respectfully submits that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Date: January 8, 2007

Respectfully submitted,


John K. Harrop
Registration No. 41,817
Andrews Kurth LLP
1350 I Street, N.W.
Suite 1100
Washington, DC 20005
Tel. (202) 662-2738
Fax (202) 662-2739